

Request for Consideration Due: 7, 2003



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Paper No. 7

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In re Application of  
Chung-Chieh Lee, et al.  
Application No. 09/803,259 ✓  
Filed: March 9, 2001  
Attorney Docket No. CM03403J

ON PETITION

This is a decision on the petition filed October 11, 2002, under 37 CFR 1.137(b), to revive the above-identified application.

The petition is **DISMISSED**.

#### BACKGROUND

The above-identified application became abandoned for failure to reply to the Notice to File Missing Parts of Non-Provisional Application – Filing Date Granted mailed May 30, 2001, which set a period for reply of two (2) months from the mail date of the Notice. The Notice required applicants to submit a declaration including the signatures of inventors Lee and Hester; and the surcharge for late filing of a declaration. In addition, the Notice stated that a filing date had been granted; however, figures 16, 17 and 18 described in the specification appeared to have been omitted. No reply having been received and no extension of time obtained, the above-identified application became abandoned on July 31, 2001. A Notice of Abandonment was mailed on June 27, 2002.

#### OPINION

On instant petition, applicant submitted a declaration, the late surcharge, and previously omitted figures 16, 17 and 18.

#### Consideration of Reply Requirement on Petition under § 1.137(B)

A grantable petition pursuant to 37 CFR 1.137(b) must be accompanied by:

- (1) the reply required to the outstanding Office action or notice, unless previously filed;
- (2) the petition fee as set forth in 37 CFR 1.17(m);

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- (3) a statement that the **entire** delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to 37 CFR 1.137(b) was unintentional. The Commissioner may require additional information where there is a question whether the delay was unintentional; and
- (4) any terminal disclaimer (an fee as set forth in § 1.20(d)) required pursuant to 37 CFR 1.137(d).

The instant petition does not satisfy requirement (1). Petitioner submitted a declaration "executed" by all of the inventors. Based on a careful review of this declaration, it appears that as to the third, fourth, fifth and sixth-named inventors, this is the same declaration submitted on original filing. However, this declaration is lacking i) the original signature blocks for the first and second-named inventors; and significantly, as to inventors 3-6, ii) the declaration that all statement herein are sworn to pursuant to Section 1001 of Title 18 of the United States Code. Rather, appended to this declaration are two signature blocks set forth on two separate pages, one executed by first-named inventor Lee and one executed by second-named inventor Hester, with significant portions of each page left blank. In addition, the pages of the declaration are not properly numbered. Although the appended pages follow the third and fourth pages of the declaration, they are numbered pages A3" and A4" respectively. Actual pages 1-4 contain no page numbering. Given the format of this declaration, it is unclear whether inventors Lee and Hester were presented with a declaration in compliance with §§ 1.63 and 1.64, naming all of the actual inventors. Accordingly, it is concluded that the declaration filed October 11, 2002, is not acceptable. Thus, the petition to revive must be dismissed.

#### **RE: Submission of Omitted Figure(s)**

The mailing of a "Notice of Omitted Items" permits the applicant to either: (1) promptly establish prior receipt in the PTO of the drawing(s) at issue (generally by way of a date-stamped postcard receipt (MPEP 503)), or (2) promptly submit the omitted drawing(s) in a nonprovisional application and accept the date of such submission as the application filing date. An applicant asserting that the missing drawings were in fact deposited in the PTO with the application papers must file a petition (and the appropriate petition fee) with evidence of such deposit. An applicant desiring to submit the omitted drawings in a nonprovisional application and accept the date of such submission as the application filing date must file any omitted drawing(s) with an oath or declaration in compliance with 37 CFR 1.63 and 1.64 referring to such drawing(s) and a petition under 37 CFR 1.182 (with the petition fee under 37 CFR 1.17(h)) requesting the later filing date within two months of the date of the "Notice of Omitted Items" (37 CFR 1.181(f)).

Applicant has not disputed that the figures were omitted. Rather, on October 11, 2002, applicant filed the instant response including one (1) sheet of drawings containing Figures 16, 17 and 18 as described in the specification; a copy of the Notice mailed May 30, 2001 and four (4) pages of a declaration containing the signatures of inventors, Le and Hester. However, applicant did not pay the petition fee under 37 CFR 1.182 and did not supply a supplemental declaration referring to the figures.

If applicant wishes to have the omitted figures submitted on petition entered into the application pursuant to the aforementioned practice, it is required that applicant submitted petition fee, along with

a supplemental oath or declaration in compliance with 37 CFR 1.63 or 1.64 referring to the amendment of the application to include Figures 16, 17 and 18. This supplemental declaration must be newly executed by all of the actual inventors.

However, if applicant seeks to amend the application to include the drawing figures, no petition under 37 CFR 1.182 is necessary for the purpose. New drawings may be entered by the primary examiner without petition so long as the new drawings contain no new matter. See MPEP § 608.02(a).

### CONCLUSION

Further correspondence with respect to this matter should be addressed as follows:

By mail: Assistant Commissioner for Patents  
Box DAC  
Washington, D.C. 20231

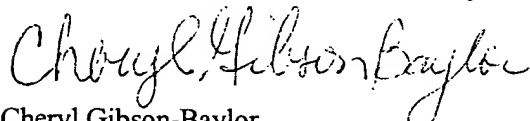
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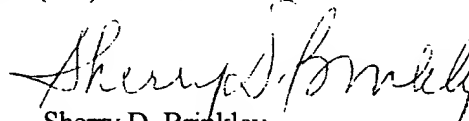
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Telephone inquiries concerning this decision should be directed to Cheryl Gibson-Baylor at (703)308-5111, or in her absence, Sherry D. Brinkley at (703)305-9220.

  
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